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09/667,301	09/25/2000	Hideo Watanabe	Q60969	1597

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Sughrue Mion Zinn MacPeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037-3202

EXAMINER	
HUNTER, ALVIN A	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/667,301
Filing Date: September 25, 2000
Appellant(s): WATANABE ET AL.

Robert Masters
Sughrue Mion, PLLC
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 6, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1, 6-12, and 14-18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

JP 11-253578 Higuchi 09-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 6-12, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higuchi et al. (JP 11-253578).

Higuchi et al. discloses a golf ball having favorable carrying characteristics, soft feeling, and excellent spin characteristics. The golf ball comprises a solid core, intermediate layer, and cover (See Abstract). The solid core has a diameter of 28 or more, a deflection (compression) of 3.2 to 5.2mm from applying a load of 130kg to 10kg, and Shore D hardness on the front face of 30 to 55 (See Paragraph 0018-0020). The specific gravity of the core is less than 1.3 (See Paragraph 0021). It is noted that the difference of a point measured at random and the front face should be no more than 10 degrees. The intermediate layer is formed of a polyurethane resin as the main material, in which is a thermoplastic polyurethane elastomer (See Abstract and Paragraph 0023). It is also noted that the polyurethane may be blended with materials such as polyamide, polyester, ionomer, etc. The cover has a Shore D hardness of 45 to

68 (See Abstract). Higuchi et al. notes that polyester was used to produce the polyurethane of the intermediate layer (See Paragraph 0025). The intermediate layer also has a Shore D hardness of 20 to 50, a thickness of 0.5 to 2.5mm, a specific gravity of 1.1 or more, and a deflection (compression) of 3.2 to 5.2mm from applying a load of 130 kg to 10kg (See Paragraphs 0029-0034). One having ordinary skill in the art would have found it obvious to have a ratio between the compression of the core and intermediate layer of any value, in particular approximately 1, as taught by Higuchi et al., in order to obtain a golf ball having good feel and flight distance.

(11) Response to Argument

Appellant argues the following issues:

A. Higuchi does not have motivation because it does not suggest the polyurethane being the primary material of the intermediate layer, and

B. Higuchi et al. does not teach or suggests the claimed compression ratio of the instant application and the motivation for the compression ratio is hindsight.

The examiner disagrees.

In regards to issue **A**, Appellant's quotes *In re Wilson* stating that "All words in a claim must be considered in judging the patentability of that claim against the prior art." The rejection above sets forth that polyurethane elastomer is the primary material. The additional language regarding the polyamide, polyester, and ionomer within the rejection only implies that though polyurethane elastomer is the main material used, these additional materials may be added thereto. The appellant's claims does not require the thermoplastic elastomer, that is the main material, to be the only material within the

intermediate layer. It appears that the appellant clearly chose to ignore the arguments made within the final rejection and chose to create an issue totally different from the issue at hand. The issue is whether the Markush group (i.e. the thermoplastic elastomer consisting from the group of polyether, polyamide, polyolefin, and polystryene) from which the material consisted is broad enough to be encompassed by the prior art. Higuchi discloses a polyurethane elastomer, which is a thermoplastic elastomer, made of a polyether polyol system. In other words, Higuchi clearly teaches "a thermoplastc elastomer consisting of polyether." This clearly meets the limitation claimed by the appellant regarding the intermediate layer composition.

In regards to issue **B**, Higuchi clearly and inherently encompasses the appellant's ratio. As shown in the above rejection, the core and intermediate layers' compressions are revealed to be of the same range, i.e. 3.2 to 5.2mm. One having ordinary skill in the art clearly would drawn therefrom that the compression ratio can be of any value, even 1, so long as the invention disclosed by Higuchi is attained. Appellant has submitted a declaration showing the compression ratio of Higuchi in which the appellant alleges shows the instant invention being unobvious. The declaration contains the golf balls used within the examples disclosed in the Higuchi reference and would appear not to obviate over the prior art being that the prior art can not be limited to only the illustrative examples. Prior art is relevant for all of which is contains (See MPEP 2123). As it stands, the appellant has not shown that the compression ratio claimed by the appellant is unobvious. The examiner assures and concludes that the above required no hindsight.

It is believed that the appellant has not set forth any issue that would substantiate the claimed invention for the prior art; therefore, the claimed invention is unpatentable.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

AAH
Alvin A. Hunter, Jr.
March 4, 2005

GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Conferees

SPE Art Unit 3725

SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037-3202